Figure 2b is a front view of eyeglasses.

Figure 3 is a flow chart illustrating a method by which a coating may be applied to a lens.

REMARKS

It should be noted that only Claims 1, 2, 9, 13, and 16 are amended. These amendments include those made in response to the Examiner's objections in paragraphs 2 and 3 of the Office Action.

Claims 1-16 are pending in the Application. Claims 1, 4-5, 7-10, 12-13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,220,538 to Brown, et. al ("the Brown patent"). For the reasons set forth below, Applicant respectfully traverses.

As described in Applicant's specification (including on page 2, first full paragraph; and page 3, second full paragraph through the third full paragraph on page 4), Applicant's invention is directed toward the application of a colored coating exclusively to the edge of an eyeglass lens, or a portion of an eyeglass lens edge for cosmetic purposes. As further described in Applicant's specification, the primary lens surfaces are preferably free of any such coating (page 7, first full sentence). Thus, Applicant's invention is not directed toward coloring the primary surfaces of the lens or the entire lens, as is taught by the Brown patent.

As described in the Abstract and at Column 4, Line 7, the Brown patent is directed to the application of a material to the edge of an eyeglass lens to cushion the lens while in an eyeglass frame. While the Brown patent does disclose the application of a material to the edge of an

eyeglass lens, the Brown patent teaches away from Applicant's invention. For example, in Column 5 in lines 48 through 55, the Brown patent teaches that a transparent to highly translucent and colorless material was preferred for the coating because a colored edge coating is distracting to the wearer and unacceptable cosmetically. In view of the discussion at column 5 of the Brown patent, that reference clearly leads one of ordinary skill in the art away from the present invention as claimed. The Court of Appeals for the Federal Circuit has consistently held that it is "error to find obviousness where references 'diverge from and teach away from the invention at hand'." In re Fine, 5 USPQ 2d, 1596, 1599 (Fed. Cir. 1988). The fact that Brown specifically teaches away from the present invention as claimed renders that reference inapplicable to the pending claims.

The Brown patent also teaches adding a hue to an entire lens by immersing the lens in a dye bath. However, the Brown patent does not teach or suggest the application of an opaque or translucent material such that the material is affixed only to the eyeglass lens edge for cosmetic purposes. Applicant's independent claims have been amended to clarify this distinction. The Court of Appeals for the Federal Circuit has consistently held that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabirk Gmbh v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1984). Brown clearly fails to disclose structure positively recited and claimed in applicant's independent claims.

Claims 1, 9, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,216,360 to Wertheim ("the Wertheim patent"). For the reasons set forth below, Applicant respectfully traverses.

The Wertheim patent discloses an apparatus for dying eyeglass lenses (abstract, Figures 1 and 2, Column 2, lines 37-57). The apparatus imparts a color to the lens as a whole, and not to only the edge of the eyeglass lens. Because the Wertheim patent does not teach or suggest the application of a translucent or opaque material only to the edge of an eyeglass lens, the Wertheim patent cannot anticipate the claimed invention under 35 U.S.C. 102(e)

Claims 1-2, 4-5, 9, and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,027,816 to Ono, et al. ("the Ono patent"). For the reasons set forth below, Applicant respectfully traverses.

The Ono patent discloses a colored plastic lens that does not discolor when dipped in a hardening solution (Column 2, lines 39-41), and which is impact- and light-resistant. The Ono patent teaches dying a lens (Column 1, lines 15-38) by dipping the lens in a coating film (column 9, line 54 and column 1, line 29) or using a sublimation technique to embed the coating film into the lens (column 1, line 34). Because the Ono patent fails to teach or suggest affixing an opaque or translucent material only to the edge of an eyeglass lens, the Ono patent cannot anticipate the claimed invention under 35 U.S.C. 102(e).

Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, et al., in view of U.S. Patent No. 4,547,397 to Burzynski, et al. ("the Burzynski patent"). For the reasons set forth below, Applicant respectfully traverses.

As previously described, the Brown patent teaches the application of a clear material to the edge of an eyeglass lens to pad the lens in a frame. The Burzynski patent teaches a tintable coating that is applied to a transparent substrate such as a polycarbonate lens, with such a tintable

coating specifically designed so as not to sacrifice scratch resistance. Neither the Burzyński patent nor the Brown patent teach or suggest the application of an opaque or translucent material only to the edge of eyeglass lenses for cosmetic purposes. It is well-established that, in order to show obviousness, all limitations in the claim must be taught or suggested by the prior art. In Re Boyka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03. It is error to ignore specific limitations distinguishing over the references. In Re Boe, 184 U.S.P.Q. 38, 505 F.2d 1297 (C.C.P.A. 1974); In Re Saether, 181 U.S.P.Q. 36, 492 F.2d 849 (C.C.P.A. 1974); In Re Glass, 176 U.S.P.Q. 489, 472 F.2d 1388 (C.C.P.A. 1973).

Further, no motivation to combine the Brown patent or the Burzynski patent with any other prior art to suggest Applicant's claimed invention has been shown. Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. Ex parte Hiyamizu 10 USPQ2d 1393 (BPAI 1988). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In re Geiger 815 F2d 686 (Fed. Cir. 1987), 2 USPQ2d 1276; In re Fine 837 F2d 1071, 5 PQ2d 1596 (Fed. Cir. 1988).

Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wertheim in view of U.S. Patent No. 4,733,959 to Claussen, et al ("the Claussen patent"). For the reasons set forth below, Applicant respectfully traverses.

As previously described, the Wertheim patent discloses an apparatus for dying eyeglass lenses. The Claussen patent teaches an apparatus and method for tinting hydrophilic contact lenses, including the use of an opaquely tinted contact lens for use as a sleep aid (Column 1, line

24). Neither the Claussen patent nor the Wertheim patent teaches or suggests the application of an opaque or translucent material to only the edge of eyeglass lenses for cosmetic purposes. Further, no motivation to combine the Claussen patent or the Wertheim patent with any other prior art to suggest Applicant's claimed invention has been shown. Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. Ex parte Hiyamizu 10 USPQ2d 1393 (BPAI 1988). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In re Geiger 815 F2d 686 (Fed. Cir. 1987), 2 USPQ2d 1276; In re Fine 837 F2d 1071, 5 PQ2d 1596 (Fed. Cir. 1988).

Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono, et al., in view of U.S. Patent No. 4,931,523 to Watanabe, et al. ("the Watanabe patent"). For the reasons set forth below, Applicant respectfully traverses.

As described above, the Ono patent is directed to a colored eyeglass lens that does not discolor when dipped in a hardening solution. The Watanabe patent discloses a copolymer plastic lens, and describes that such a lens may be easily dyed (Column 1, lines 26-40). Neither the Watanabe patent nor the Ono patent teaches or suggests the application of an opaque or translucent material to only the edge of eyeglass lenses for cosmetic purposes. Further, no motivation to combine the Watanabe patent or the Ono patent with any other prior art to suggest Applicant's claimed invention has been shown. Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. Ex parte

Hiyamizu 10 USPQ2d 1393 (BPAI 1988). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In re Geiger 815 F2d 686 (Fed. Cir. 1987), 2 USPQ2d 1276; In re Fine 837 F2d 1071, 5 PQ2d 1596 (Fed. Cir. 1988).

CONCLUSION

From the arguments above, it should be clear that the references cited by the Examiner, taken singularly or in combination, do not teach or suggest the Applicant's invention. Having responded to all objections and rejections set forth in the outstanding Office Action, it is submitted that claims 1-16 are in condition for allowance and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is courteously requested to contact applicant's undersigned representative.

Respectfully submitted,

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